

## **REMARKS**

### **I. Introduction**

Claims 1, 3 – 14, and 17 – 21 are presently pending and rejected.

### **II. Rejections under 35 USC § 103(a)**

Claims 1, 3 – 14, and 17 - 21 are rejected under 35 USC 103(a) as being unpatentable over Halliday (US 7,340,990) in view of Fox (US 2,977,231) and Rusoff (US 2,954,293).

In response to Applicants January 12, 2010 arguments, the Examiner finds that a reference may be relied upon for all that would have reasonably suggested to one having ordinary skill in the art, including non preferred embodiments, and the passage cited by Applicants does not clearly teach away from adding cocoa powder to the cacao flavoring composition of Rusoff. Rather, the Examiner finds Rusoff suggests the inclusion of cacao solids may not be most preferred.

Applicants respectfully request reconsideration. Applicants submit that the inclusion of cacao solids is not only not preferred, but completely contrary to the disclosure of Rustoff.

Rusoff clearly teaches there are problems with using cocoa powder in beverages. Turbid products are produced. Col. 1, line 26. Cocoa particles settle out and collect on the bottom of containers in the form of a sediment. Col. 1, lines 27 – 30. The use of starches and gum to hinder settling of insoluble cocoa powder particles results in foreign tasted, increased viscosity and sliminess. Col. 1, lines 30 – 45.

Rusoff continues to discuss methods of preparing water-soluble products containing full-bodied chocolate flavor and aroma. Col. 1, lines 47 - Col. 2, line 45.

It is clear that water soluble chocolate flavoring compositions should not have cacao solids. Col. 50, lines 49 – 51. One object of Rusoff is to provide for flavoring material which is substantially free of non-suspensible solids. Col. 3, line 1 – 4. The process of Rusoff allows the production of chocolate flavoring material which is free of solids. Col. 4, lines 10 – 12.

Mere identification in the prior art of each component of a composition does not show that the combination as a whole lacks the necessary attributes for patentability, i.e., is obvious. *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006). To establish a prima facie case of obviousness based on

a combination of elements in the prior art, the law requires a motivation to select the references and to combine them in the particular claimed manner to reach the claimed invention. *Eli Lilly and Co. v. Zenith Goldline Pharma., Inc.*, 471 F.3d 1369 (Fed. Cir. 2006).

It is clear that Rusoff seeks to omit cocoa powder in its composition, and there is no teaching, suggestion or motivation that would lead one of skill in the art to combine its cocoa flavoring with cocoa powder.

Claims 1, 3 – 6, 8 – 14 and 17 – 21 all depend from claim 7. As the composition of claim 7 is neither disclosed or suggested by the teachings of Halliday, Rusoff and Fox, either individually or combined, the references cannot teach or suggest all of the limitations of the claims that depend therefrom, and Applicants request the rejection be withdrawn.

#### IV. Summary

Applicants have made a *bona fide* attempt to address all matters raised by the Examiner. Applicants respectfully submit that the application is now in condition for allowance, and therefore respectfully request that the outstanding rejections be withdrawn and that a Notice of Allowance be issued. If any remaining matters need to be resolved, Applicants respectfully request an interview with the Examiner prior to any official action being taken by the Office in response to these arguments and amendments in order to facilitate allowance of the pending claims.

It is believed no fee other than the RCE filing fee is currently required. If any additional fee is required, please charge the same to Deposit Account 50-4255.

Respectfully submitted,

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